

REMARKS

Claims 1 through 10 are pending in this application. Applicants acknowledge, with appreciation, the Examiner's indication that claims 3 and 4 contain allowable subject matter. Accordingly, the only remaining issue pivots about the patentability of claims 1, 2 and 5 through 10.

Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the original filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

Title

The Examiner asserted that the title of the invention is not descriptive and courteously suggested a new title. In response, the title has been amended consistent with the Examiner's suggestion.

Claims 1 and 9 were rejected under 35 U.S.C. §103 for obviousness predicated upon U.S. Patent No. 6,173,105 issued to Aksyuk et al. (Aksyuk '105).

This rejection is traversed

Applicants submit that Aksyuk '105 neither discloses nor suggests an actuating means comprising a comb-shaped electrode as specified in independent claims 1.

Claim 1 has been clarified by reciting that the actuating means comprises a comb-shaped electrode. In the Office Action dated February 12, 2003, the Examiner admitted that Aksyuk '105 does not disclose such an electrode structure (page 4, third paragraph). There is no apparent factual basis of record upon which to predicate the conclusion that one having ordinary skill in the art would have realistically impelled to modify the optical device disclosed by Aksyuk '105 by forming an actuating means with a comb-shaped electrode absent improper reliance upon Applicant's disclosure. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985).

Applicants, therefore, submit that the imposed rejection of claims 1 and 9 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 2 is rejected under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 in view of Chai et al.

This rejection is traversed.

Specifically, claim 2 depends from independent claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105. Indeed, Aksyuk '105 neither discloses nor suggests an optical device as claimed, wherein the actuating means comprises a comb-shaped electrode. The additional reference to Chai et al. does

not cure argued deficiencies of Aksyuk '105. Accordingly, even **if** the applied references are combined, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claim 2 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 in view of Chai et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

Claim 5 was rejected under 35 U.S.C. §103 for obviousness predicted upon Aksyuk '105 in view of U.S. Patent No. 5,923,798 issued to Aksyuk et al. (Aksyuk '798).

This rejection is traversed.

In the statement of the rejection, the Examiner concluded that Aksyuk '798 "...teaches a similar electrode structure in a switching device having a shutter" (page 4 of the February 12, 2003 Office Action lines 9 and 10). This rejection is traversed.

Applicants disagree with the Examiner's determination that Aksyuk '798 "... teaches a similar electrode structure in a switching device having a shutter." This determination is factually inaccurate.

Specifically, adverting to the first embodiment illustrated in Fig. 1 of Aksyuk '798 (the in-plane optical switch), optical device 8 is moved by hinged plate actuator 4a (column 3, lines 1 and 2) having a fixed electrode 20 and movable electrode 30 (column 3, lines 33 through 35). Electrodes 20 and 30 are plate electrodes (Fig. 2).

In the second embodiment (out-of-plane optical switch) illustrated in Fig. 6 of Aksyuk '798, the optical device 8 is moved by plate actuator 4b (column 6, lines 6 and 7) having plate electrodes 80a and 80b (column 6, lines 30 through 32).

It should, therefore, be apparent that Aksyuk '798 neither discloses nor suggests the use of a comb-shape electrode as in the claimed invention. Accordingly, even if the applied references are combined, the claimed invention would **not** result.

Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.

It should, therefore, be apparent that the combined disclosures of Aksyuk '105 and Aksyuk '798 would not even yield the invention defined in independent claim 1. Applicants would traverse this rejection as though it were applied against independent claim 1, as claim 1 has been amended to provide for the comb-shaped electrode.

Based upon the foregoing, Applicants submit that the imposed rejection of claim 5 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 in view of Aksyuk '798 is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 6 through 8 and 10 were rejected under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 in view of Eu.

This rejection is traversed. Claims 6 through 8 and 10 depend from claim 1. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 1 and claim 5 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 alone and in view of Aksyuk '798. Indeed, neither Aksyuk '105 nor Aksyuk '798 discloses or suggests an actuating means comprising a comb-shaped electrode. The additional reference to Eu does not cure the argued deficiencies of

Aksyuk '105 and Aksyuk '798. Ergo, even if the applied references are combined, the claimed invention would **not** result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*.

Applicants, therefore, submit that the imposed rejection of claim 6 through 8 and 10 under 35 U.S.C. §103 for obviousness predicated upon Aksyuk '105 in view of Eu is not factually legally viable and, hence, solicit withdrawal.

"Silicon Micromachining High Technology"

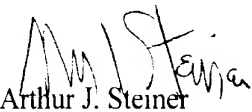
Applicants submitted an Information Disclosure Statement on January 17, 2002 citing "Silicon Micromachining High Technology" Science Forum, March 1992. The Examiner included with the February 12, 2003 Office Action a copy of Form PTO-1449, which was submitted with the January 17, 2002 Office Action, indicating consideration of the cited references, including the "Silicon Micromachining High Technology" publication. In order to ensure that the Examiner has a complete understanding of the "Silicon Micromachining High Technology" publication, a Supplemental Information Disclosure Statement is submitted concurrently herewith including an English Language Translation of the "Silicon Micromachining High Technology" publication.

claims 3 and 4 contain allowable subject matter. Based upon the arguments submitted *supra*, it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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